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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,774	08/13/2001	Gisela F. Erf	00038	4035

24118 7590 12/11/2002  
HEAD, JOHNSON & KACHIGIAN  
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EXAMINER

PARAS JR, PETER

ART UNIT PAPER NUMBER

1632

DATE MAILED: 12/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/913,774

Applicant(s)

ERF ET AL.

Examiner

Peter Paras, Jr.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to an animal exhibiting pulmonary hypertension and/or pulmonary hypertension syndrome.

Group II, claim(s) 2-3, 5 and 15, drawn to processes for producing a population of animals having increased resistance to pulmonary hypertension.

Group III, claim 4, drawn to animals that are resistant to pulmonary hypertension.

Group IV, claim 6, drawn to genetic breeding stock.

Group V, claims 7-9, drawn to processes of using genetic breeding stocks to produce cattle, broiler chickens, or pigs which are resistant to pulmonary hypertension.

Group VI, claims 10 and 12-13, drawn to a method of using animals that are resistant to pulmonary hypertension to identify novel DNA allelic markers that indicate resistance to pulmonary hypertension.

Group VII, claims 11-13, drawn to a method of using animals that are susceptible to pulmonary hypertension to identify novel DNA allelic markers that indicate susceptibility to pulmonary hypertension.

Group VIII, claim 14, drawn to an assay or test for resistance to pulmonary hypertension.

Group IX, claim 14, drawn to an assay or test for susceptibility to pulmonary hypertension.

The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features for the following reasons:

- a. Claim 1 is directed to an animal exhibiting pulmonary hypertension. Bottje et al (Poultry Science, 1997, Vol. 76: 1506-1512) teaches broiler chickens exhibiting pulmonary hypertension. Thus, animals that exhibit pulmonary hypertension are known in the art. Therefore, the invention of claim 1 is not free of the prior art and so cannot constitute a special technical feature that links the independent claims of the instant application.
- b. Groups II-IX are drawn to a process for producing a population of animals having increased resistance to pulmonary hypertension, animals that are resistant to pulmonary hypertension, genetic breeding stock, processes of using genetic breeding stocks to produce cattle, broiler chickens, or pigs which are resistant to pulmonary hypertension, methods of using animals that are resistant to pulmonary hypertension to identify novel DNA allelic markers that indicate resistance to pulmonary hypertension, a method of using animals that are susceptible to pulmonary hypertension to identify novel DNA allelic markers that indicate susceptibility to pulmonary hypertension, an assay or test for resistance to pulmonary hypertension, an assay or test for susceptibility to pulmonary hypertension respectively. Groups II-IX are wholly different inventions, each from the other, as defined by being methods and products, having different modes of operation for different objectives and effects which may require use of materially different products having different chemical structures or different methods

that require materially different products and different technical considerations; thus, the groups are different categories of inventions. Therefore, because there is no special technical feature free of the prior art, as discussed above, unity of invention is lacking in the instant application and restriction is proper.

PCT Rules 13.1 and 13.2 do not provide for multiple products and methods within a general inventive concept. Note 37 CFR 1.475 and MPEP 1895.01 (section 4) and 1896.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at 703-305-4051. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703) 308-4242 and (703) 305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Dianiece Jacobs whose telephone number is (703) 305-3388.

Peter Paras, Jr.

Art Unit 1632

*Pete Paras Jr*  
*Art Unit 1632*